The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SATOSHI NAKAMURA

Appeal No. 2004-1412
Application 09/818,686

ON BRIEF

Before KIMLIN, WARREN and OWENS, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

Order For Compliance With 37 CFR § 1.196(b) (2003)

In our decision dated August 24, 2004, we reversed the decision of the examiner and pursuant to our authority under 37 CFR § 1.196(b) (2003), we entered a new ground of rejection of appealed claims 1, 6, 7, 10 through 13 and 15 through 22, all of the claims in the application, under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Christopher and Miyagi.

Our decision concluded with the following requirement):

> This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (2003). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."
>
> 37 CFR § 1.196(b) also provides that the appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of

proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . . [Pages 9-10.]

The second paragraph of the requirement makes clear that appellant *must exercise one of the two specified options in order to avoid termination of the proceedings under 37 CFR § 1.197(c) (2003).* The purpose of the rules is to have the entirety of appellant's response to the new ground of rejection considered by the Board or by the examiner to provide order to the continued proceeding for judicial economy, otherwise avoiding piecemeal prosecution before the Board and the examiner wherein the Board could further twice consider the appeal.

The same requirements with respect to a response to a new ground of rejection in a Board decision are set forth in 37 CFR §1.41.50(b) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

On December 16, 2004, appellant filled a request for rehearing styled as under 37 CFR § 1.196(b), wherein "Appellant respectfully submits that *Christopher* and *Miyagi* . . . do not teach or suggest at least the features of claim 7 . . . [and] will address claims 1, 6, 7, 10-12, 14-18 and 20-22 with an appropriate amendment after the rehearing regarding claim 7" (request, pages 3-4).[1]

Appellant's response does not comply with the stated rules in 37 CFR § 1.196(b) or in 37 CFR §1.41.50(b) because we are asked to consider only appealed claim 7 and the amendment to be filed with respect to the remaining appealed claims would result in a new record which would be considered by the examiner.

In view of appellant's stated intent to further prosecute the remaining appealed claims by amendment before the examiner, we will not consider appealed claim 7 on the record as it stood at the time of appeal in light of appellant's arguments in the request for rehearing and terminate the proceedings with respect to the remaining rejected claims not addressed in the request by

[1] We note here that appellant does not account for appealed claims 13 and 19 and includes a claim "14" which was not of record at the time of the appeal.

dismissing the appeal with respect to. The dismissal of the appeal would, of course, result in the loss of those claims.

Instead, appellant is hereby *ORDERED* to comply with 37 CFR § 1.196(b) (2003), now 37 CFR §1.41.50(b) (2004), as stated in our original decision by exercising *one* of the two stated options set forth therein with respect to *all* of the appealed claims which appellant intends to prosecute *WITHIN A NON-EXTENDABLE TIME PERIOD OF ONE (1) MONTH FROM THE DATE OF THIS DECISION ON REHEARING* in order to avoid termination of proceedings as to the rejected claims.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

EDWARD C. KIMLIN)
Administrative Patent Judge)
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CHARLES F. WARREN) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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